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SEP 23 2003

OFFICE OF PETITIONS

In re Application of :
Yehuda Afek, et al. :
Application No. 09/929,877 : DECISION GRANTING PETITION
Filed: August 14, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 0103376-00003 :

This is a decision on the petition, filed September 2, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. See 37 CFR 1.137(f).

The petition is GRANTED.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on October 16, 2001. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country. Petitioner explains that it was believed that the filing of a "'PCT Request' with the USPTO United States Receiving Office fully met their obligation under 35 U.S.C. 112(b)(2)(B)(iii) to notify the USPTO of the foreign or international filing of such invention."

37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b) provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is

not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the October 16, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law after midnight November 30, 2001.

A petition to revive an application abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

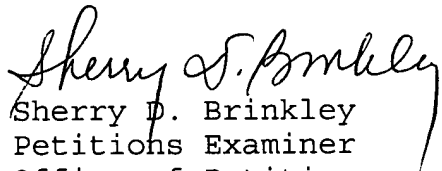
- (1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and
- (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.


The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after

the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

Any inquiries concerning this decision may be directed to Sherry D. Brinkley at (703) 305-9220.

This application is being forwarded to Technology Center Art Unit 2171 for examination in due course.


Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Conferee: Frances M. Hicks 
Lead Petitions Examiner